

REMARKS

In the Office Action mailed October 19, 2006, claims 1-36 were pending for consideration, and claims 37 and 38 were withdrawn as a result of a restriction requirement. The Examiner has objected to the drawings under 37 C.F.R. 1.84(p)(5) due to a missing reference description. The Examiner has also rejected claims 1-36 under 35 U.S.C. 102(b) as being allegedly anticipated by U.S. Patent No. 5,626,611 (hereinafter "Liu"). Claims 1, 4, 10, 13, 16, 22, 25, and 35 have been amended. Support for these amendments can be found, *inter alia*, in claims 6, 7, 18, 19, 30, and 31 as originally filed. The Applicants stress that these amendments have been made in an effort to advance the prosecution of the present application, and as such, should not be seen as agreement with the positions taken by the Examiner. Additionally, claims 6, 7, 9, 18, 19, 21, 30, 31, and 33 have been canceled, and claims 39 and 40 have been added. The Applicants reserve the right to pursue any canceled or otherwise withdrawn subject matter in future applications. Additionally, Applicants hereby declare that the amendments made herein do not include any new matter. Claims 1-5, 8, 10-17, 20, 22-29, 32, 34-36, 39, and 40 remain pending for consideration in the present application, and Applicants respectfully submit that these claims are in condition for allowance.

Drawing Objection

The drawings have been objected to under 37 C.F.R. 1.84(p)(5) due to a missing reference description, namely reference 35 in FIG. 3A. The specification has been amended to include a description for reference 35. The description for the structure

referred to in FIG. 3A by reference 35 can be found in the second paragraph beginning on page 8 of the specification. No new matter has been introduced by this amendment.

35 U.S.C. § 102(b) Rejections:

The Examiner has rejected claims 1-36 under 35 U.S.C. 102(b) as being allegedly anticipated by Liu. While the Applicant is confident that the Examiner is well acquainted with the requirements necessary to establish a rejection under 35 U.S.C. 102, it is thought prudent to briefly review these requirements. It is well settled that "[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). In order to establish anticipation under 35 U.S.C. 102, all elements of the claim must be found in a single reference. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), *cert. denied* 107 S.Ct. 1606 (1987). In particular, as pointed out by the court in *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1981), *cert denied*, 469 U.S. 851 (1984), "anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference." "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.* 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

With this background in mind, the Applicants respectfully submit that Liu does not teach each and every element of independent claims 1, 13, and 25. Liu teaches co-extruding a core polymer and a shell polymer to form a core/sheath type suture. In one embodiment, the core may be of absorbable polymers, copolymers, or mixtures fabricated

from polydioxanone, polycaprolactone, and polytrimethylene carbonate. The shell may be of bioabsorbable polymers, copolymers, or mixtures fabricated glycolide or glycolic acid. (col. 3, line 38 to col. 4, line 20).

The amended independent claims of the present application contain limitations to, *inter alia*, a monofilament suture prepared by co-extruding a first absorbable polymer and a second absorbable polymer having a Young's modulus lower than the Young's modulus of the first polymer, wherein the first polymer surrounds the second polymer such that said suture has improved knot security and flexibility, and wherein the Young's modulus of the first polymer and the second polymer is 3.0 GPa or less, and wherein the difference of the Young's modulus between the first polymer and the second polymer is 0.3 GPa or more, and wherein the second polymer a copolymer comprising dioxanone, trimethylene carbonate, and caprolactone.

The Applicants respectfully submit that the Liu reference does not teach or suggest each of these limitations. A polymeric material for making a monofilament structure according to the claims of the present invention should have a Young's Modulus of 3.0 GPa or less. A material having Young's Modulus higher than 3.0 GPa is considered by the Applicants to be too rigid, and thus is not suitable for such a monofilament. Liu requires using glycolide and lactide copolymers which have Young's Modulus of glycolide and lactide copolymer (90%:10%) of about 5.8 Gpa, an amount that is greater than the limitation of the present claims of 3.0 Gpa or less. Accordingly, Liu does not teach each and every element of the amended independent claims. As such, withdrawal of the rejections of claims 1, 13, and 25 is respectfully requested. Additionally, claims 2-5, 8, 10-12, 14-17, 20, 22-24, 26-29, 32, and 34-36 depend from

independent claims 1, 13, and 25 and are considered to be narrower in scope.

Withdrawal of the rejections of these claims is also respectfully requested.

Applicants acknowledge that newly added claims 39 and 40 mirror withdrawn claims 37 and 38 with the exception that the limitations of amended claim 1 had been added to claim 39. To that end, given the limitations as to specific monomer components, the process of claim 39 cannot be used to prepare monofilament sutures other than those specifically claimed in amended claim 1. Therefore, restricting claims 39 and 40 is submitted not to be appropriate. However, in the event the Examiner does not agree with Applicants position and in the further event that claims 1-5, 8, 10-17, 20, 22-29, 32 and 34-36 are otherwise considered to be allowable, the Examiner is authorized to cancel withdrawn claims 37 and 38 and also cancel newly submitted claims 39 and 40 by Examiner's Amendment and pass this case to issue.

CONCLUSION

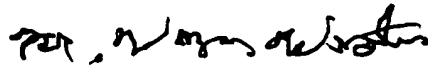
In view of the foregoing, the Applicants assert that claims 1-5, 8, 10-17, 20, 22-29, 32, 34-36, 39, and 40 of the present application present allowable subject matter and the allowance thereof are requested. If any impediment to the allowance of these claims remains after consideration of the present amendment and above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone Dr. Todd Alder, or in his absence, Mr. M. Wayne Western, so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 20-0100.

Dated this 18th day of January, 2007.

Respectfully submitted,

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